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PATENT
Docket No. P1230

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPELLANT: NOEL LEE

SERIAL NO.: 09/735,697

EXAMINER: DEBERADINIS, ROBERT

FILED: DECEMBER 12, 2000

ART UNIT: 2836

FOR: APPARATUS AND METHOD FOR POWERING MULTIPLE
PERIPHERAL DEVICES FROM A COLOR-CODED CENTRAL POWER
SOURCE

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APPLICANT'S REPLY BRIEF

To the Commissioner:

Applicant submits this brief in reply to the Examiner's Answer mailed June 27, 2006. As set forth in Applicant's Appeal Brief, this Reply Brief and the file history, it is respectfully submitted that the claimed invention is patentable over the cited art. Reversal is respectfully requested.

The Examiner argues that the rejection of the claims over U.S. Patent No. D401,220 to Dwight ("Dwight") in view of U.S. Patent No. 5,775,935 to Barna ("Barna") and, as applied to Claims 50, 51, in further view of U.S. Patent No. 5,708,554 to Liner ("Liner") and, as applied to Claim 53, in further view of U.S. Patent No. 5,899,761 to Crane ("Crane") is proper. In support of this position, the Examiner concludes that it would have been obvious to combine the teachings of Dwight with Barna, and such combination would render the claimed invention obvious.

The presently pending claims are directed to a AC electrical power distribution system that distinguishes the identity of particular receptacles among a group of identical receptacles, and related method. The apparatus claims, Claims 49-57, require a housing having a plurality of colored areas thereon. These colored areas are used for selectively identifying each outlet (receptacle). The method claims, Claims 58-62, selectively identifying identical outlet on a power strip by providing colored indicia to separate and distinct areas on and around each outlet.

Given the piecemeal prosecution arising from this matter being assigned to at least three (3) different examiners, Applicant believes the focus of this application has become blurred. In an attempt to refocus on the main issue in this matter, Applicant submits that the Examiner has (a) has failed to make a prima facie case of obviousness by not providing sufficient motivation to combine the Dwight and Barna references, (b) engaged in improper hindsight when combining the Dwight and Barna references and (c) improperly discounted secondary consideration evidence.

Given the long file history, it is understandable the current Examiner may not be aware that both the Dwight and Barna references have previously been cited and withdrawn by this matter's initial examiners. A review of the record will show that Examiner Polk withdrew these references, Dwight and Barna, in her Office Action dated May 6, 2002. Thus, these references have already

been considered with respect to the currently pending claims, which are substantially the same as those to which these references were applied by Examiner Polk.

A. Examiner Has Not Provided Sufficient Motivation to Combine The Cited References.

Regarding the rationale for combining the Dwight and Barna references, the Examiner indicated that such motivation to combine would be to “provide an indication as to which device was not plugged into the power strip.” (Examiner’s Answer, p. 4). A review of these references shows there is no motivation for any combination therewith.

The Barna reference is directed toward the use of a hardwired pattern-colored template applied to a credit card terminal and not a flexible color-coding system applied to the instant plug strip apparatus. It cannot be said Barna teaches, suggests or has any motivation to be used in connection with a power strip. Thus, the motivation to combine must come from the Dwight references.

The Dwight reference, however, discloses a power strip have thin ornamental colored rings disposed at a notable radius away from the outlets. As this reference is a design patent, and thus no written description as with a utility patent, there is no teachings or suggestion contained therein.

The Examiner argues that the motivation for this combination of references is to provide an “indication” as to which device is “not plugged into the power strip.” This makes the assumption that the Dwight device is concerned with what type of device(s) utilize its power outlets. It is submitted that the Dwight device only discloses ornamental features, and not any functional features or uses. In support herewith, the subject matter of Dwight has been previously cited during this matter’s prosecution, in a product review article by Leonard Wiener, entitled “SmarterStrip,” U.S. News & World Report, published May 5, 1997, and as an anonymous article,

entitled “Designer Surge Protectors Debut from Kensington,” *Twice*, published April 7, 1997. As the title of this article suggests, the Dwight device is directed toward the aesthetic aspects of the device, i.e. being “designer” surge protector. To make the assumption that Dwight can suggest something other than aesthetic features goes beyond its teachings and is improper.

Thus, the Examiner has not provided sufficient motivation to combine the Dwight and Barna references, and accordingly, has failed to make a prima facie case of obviousness. Reversal of the Examiner’s rejections is respectfully requested.

B. Examiner Engaged in Improper Hindsight

The Examiner in his Answer acknowledges that he engaged in hindsight when combining these references, but indicates that such hindsight is “proper.” Applicant, however, disagrees and submits that such hindsight was not proper.

The case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The Court of Appeals for the Federal Circuit has noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved although “the suggestion more often comes from the teachings of the pertinent references,” The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.” Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact. *Id* at F.3d

999-1000, 50 USPQ2d 1614 (Fed. Cir. 1999) (citations omitted).

The obviousness analysis in the Examiner's rejection of the pending claims is limited to a discussion of the ways that the disclosure contained in a design patent and a utility patent can be combined to read on the claimed invention. Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the Dwight and Barna references teach or suggest their combination to yield the claimed invention. *See, In re Dembiczak, supra*. ("Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand."). *See Rouffet*, 149 F.3d at 1357, 47 U.S.P.Q.2D (BNA) at 1459 (noting Board's failure to explain, when analyzing the prior art, "what specific understanding or technical principle . . . would have suggested the combination").

The present Examiner's reasoning during the prosecution of this matter, and set out in the Answer, uses the Applicant's claimed invention as "a template for piecing together" bits from the cited references. The Examiner states that "Dwight discloses a power strip having ... colored areas," but concedes that Dwight does not teach the colored areas are for selectively identifying each outlet. However, Dwight's colored elements are merely ornamental colored rings as evident from the figures. The Examiner pieces together the present invention by impermissibly combining Barna's pattern-colored alignment strip (template) over non-identical ports with Dwight's ornamental colored rings. Dwight, by virtue of being a design patent, teaches non-functional elements, i.e., merely ornamental colored rings. Neither reference nor the combination of these references teaches, suggests, nor motivates a utilitarian color coding feature for substantially identical outlets as is claimed in the present invention.

Thus, the Applicant's teachings have been used to "piece-together" the cited references in the Office Action. As such, the Examiner has engaged in the practice of basing the rejection on impermissible hindsight reconstruction.

C. Examiner Failed To Consider Secondary Consideration Evidence

The Examiner further discounted the Declaration of the Applicant Noel Lee, of record, which testifies to commercial success on the order of 458,010 units sold worth \$8,857,605.13 in wholesale sales in one year as well as to the nexus between this commercial success and the merits, i.e., color-coding the plug strip, the claimed features of the present invention, and the Declaration of Retailer Karen Johnson, which testifies to commercial success on the order of 31,657 units sold worth \$1,487,796.83 in retail sales in one year as well as to the nexus between this commercial success and the merits, i.e., the color-coding of the substantially identical outlets of the plug strip, of the claimed invention. Applicant disagrees with the Examiner, and that this information is proper evidence showing commercial success, and as such, further indicates the non-obviousness of the claimed invention over the cited references.

Alternatively, such evidence is proper secondary consideration evidence. It shows significant sales of the claimed invention.

Another factor, separate from that of commercial success, is the fact that after the introduction of Applicant's products having the claimed system that distinguishes the identity of particular receptacles, as set out above, a competitor, Kensington (ACCO), i.e., Assignee of the Dwight reference, promptly started to apply color-coding to its power strips having substantially identical outlets as demonstrated by the Declarations of the Applicant Noel Lee (para. 6 of both Declarations). Indeed, former Examiner Polk, in the November 5, 2001 second final Office Action

(para. 4), concedes that the Declarations of Noel Lee and Karen Johnson "may be persuasive regarding commercial success and long felt need." Furthermore, the evidence of record suggests that Kensington actually acquired the invention from a former employee of the present invention's Assignee.

In addition to the Declarations of Noel Lee and Karen Johnson, the Applicant believes the Examiner should have given full weight to Expert Witness Dr. Mehrabian's Rule 1.132 Declaration, which states that he expects there to be a "substantial advantage in using solid colors of high chroma" and which supports patentability in that "expected beneficial results are evidence of obviousness just as unexpected results are evidence of unobviousness." *In re McLaughlin* also held that "[a] patentable invention, within the ambit of 35 U.S.C. 103, may result even if the inventor has, in effect, merely combined features, old in the art, for their own purpose, without producing anything beyond the results inherent in their use." Therefore, even if the combination of the instant claimed elements only produced results "inherent in their use," i.e., "expected beneficial results," as is asserted by the Examiner, the Applicant respectfully submits that this circumstance would not and does not preclude patentability under *McLaughlin*.

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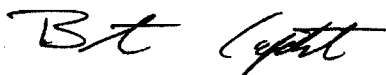
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CONCLUSION

For the reasons set forth above, along with those set out in Applicant's Appeal Brief and File History, it is respectfully submitted that Claims 49-62 are patentable over the cited references, and it is respectfully requested that the currently rejection be reversed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Bt Capehart", written in a cursive style.

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